

## REMARKS

### I. Summary of the Requirement

In a Requirement for Restriction and Election of Species (the "Requirement") dated May 1, 2008, the Examiner requires restriction under 35 U.S.C. § 121 and 372 to one of the following groups of claims for examination:

Group I: Claims 65-136 are "drawn to a lip makeup composition."

Group II: Claims 137-142 are "drawn to a cosmetic assembly."

Group III: Claims 143 and 144 are "drawn to a cosmetic process."

Group IV: Claims 145 and 146 are "drawn to a method for making a lip makeup composition."

See Requirement, page 2.

As the basis for the Requirement, the Examiner indicates that Groups I to IV "do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature among the inventions is the lip makeup composition, which is anticipated by Anton *et al.* (U.S. Patent No. 6,153,206; Issued Nov. 28, 2000; #35 on the IDS submitted by applicant dated 9/21/2006)." *Id.* Further, the Examiner contends that the application "contains claims directed to more than one species of the generic invention," and that "these species are deemed to lack unity of invention because they are not so linked as to form a single inventive concept under PCT Rule 13.1." *Id.* at 3.

## II. Response to the Requirement

Applicants respectfully disagree with and traverse the Requirement for the reasons set forth below. However, to be fully responsive, Applicants elect with traverse to prosecute Group I, claims 65-136. In addition, Applicants elect the monomer isobornyl (methyl)acrylate, i.e.,  $\text{CH}_2=\text{C}(\text{CH}_3)-\text{COOR}_1$  where  $\text{R}_1$  = a  $\text{C}_{10}$  cycloalkyl group, specifically, a 1,7,7-trimethylbicyclo[2.2.1]heptanyl group for examination. Claims 65-136 read on these species. Furthermore, Applicants elect acrylic acid, i.e.,  $\text{CH}_2=\text{CHCOOR}_{10}$  where  $\text{R}_{10}$  is H as the additional monomer for examination. Claims 107-111 read on this species.

Applicants respectfully submit that the Requirement for restriction does not comply with the regulations regarding unity of invention practice. Under 37 C.F.R. § 1.475(a) “[a]n international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” (emphasis added)

In addition, “[w]hen making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims; and (2) explain why each group lack unity with each other group (i.e. why there is no single general inventive concept) specifically describing the unique special technical feature in each group.” (emphasis added). *Id.*

As such, proper consideration of the claim language in view of PCT rules 13.1 and 13.2 reveals that the pending claims do possess unity of invention, and thus must be examined together. Indeed, each of the pending independent claims (65, 137, 143, and 145) contain the same corresponding special technical feature, i.e., “at least one block ethylenic polymer is such that, when it is present in a sufficient amount in the composition, the lip makeup composition can form a deposit that has a resistive index of greater than or equal to 80%.” See Claims 65, 137, 143, and 145. Furthermore, the International Preliminary Examination Report for PCT/FR03/02843 (“IPER”), to which this application claims priority under 35 U.S.C. § 371, indicates that there is, in fact, unity of invention. See IPER at p. 2. (copy enclosed).

In the present Requirement, however, the Examiner does not identify this special technical feature incorporated in each of groups I, II, III, and IV, as required by M.P.E.P. § 1893.03(d). Rather, the Examiner makes the general assertion that each of groups I to IV are anticipated by U.S. Patent No. 6,153,206 (“Anton”) and therefore do not share a common special technical feature.

As clearly set forth in the M.P.E.P. “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131 (8<sup>th</sup> ed. Sept. 2007 Rev.) (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added). In addition, “prior art which teaches a value or range that is very close to, but does not overlap or touch, the claimed range does not anticipate the claimed range.” M.P.E.P. § 2131.03(III). To anticipate the claims, Anton must teach each and every element of the claims and disclose any amounts, ranges,

and/or ratios that overlap or fall within the scope of the claimed amounts, ranges, and/or ratios.

Here the cited reference fails to meet these requirements. Anton describes a cosmetic composition comprising an uncrosslinked synthetic polymer consisting of two methacrylate ester monomers, which if polymerized, would yield polymers having a glass transition temperature (T<sub>g</sub>) of -10 to 75 °C and 76 to 120 °C respectively. *Anton* at col. 2, lines 12-22. However, Anton does not teach or discuss a composition that forms a deposit that has a resistive index, let alone the specific resistive index range as claimed.

Therefore, Anton does not disclose each and every element of the claims, and consequently does not anticipate the present claims. Accordingly, Applicants respectfully request that the Requirement for Restriction and Election of Species be withdrawn, and that all claims be examined on the merits.

If the Examiner chooses, however, to maintain any of the above mentioned restrictions and elections, Applicants expect that the Examiner, if the elected species is found allowable, to continue to examine the full scope of the pending claims to the extent necessary to determine the patentability of these pending claims, i.e., extending the search to a reasonable number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121. Moreover, if the restriction requirement is maintained between the claims of Groups I-IV, Applicants respectfully remind the Examiner of the obligation to rejoin the non-elected claims under M.P.E.P. § 821.04 should the elected claims be found allowable.

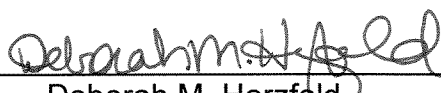
**Conclusion**

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: May 29, 2008

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**Attachment:           Copy of International Examination Report for PCT/FR03/02843**